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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/881,587	06/14/2001	John Werner Bulluck	TRIA:002	5873

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EXAMINER

SELLERS, ROBERT E

ART UNIT PAPER NUMBER

1712

DATE MAILED: 03/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/881,587

Applicant(s)

BULLUCK ET AL.

Examiner

Robert Sellers

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 17 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-6, 8-15 and 88-100 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-15 and 88-100 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The 35 U.S.C. 112, second paragraph, rejection of claims 1-6 and 8-15 is rescinded due to the amendments to claims 1 and 3.

Claims 3 and 89 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

There is no clear line of demarcation between the tetraethyleneglycol trimethacrylate and polyethylene glycol trimethacrylate in line 9 of claim 3 and lines 8-9 of claim 89 since the tetraethyleneglycol portion of the former is a specific polyethylene glycol of the latter. The denotation of the latter as "polyethylene glycol trimethacrylate other than the tetraethylene glycol trimethacrylate" would resolve this issue.

The amendment filed March 17, 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is the change in the minimum amount of alkylene glycol dimethacrylates on page 11, line 12 from 80 percent to 5 percent. Table 2 on page 15, Part B substantiates a minimum proportion of 5.57% by weight with respect to EGDM.

Applicant is required to cancel the new matter or amend the 5 percent to 5.57 percent in the reply to this Office Action.

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The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-6, 8-14 and 88-100 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The concentration of the difunctional methacrylate monomer is limited to from 10 to 80 percent by weight in claim 1, lines 13-14 and claim 15, lines 14-15. The quantity of any other monomers in claim 4, lines 3-4 and claim 90 is confined to from about 5 to about 30 percent. However, the proportions are not enabled unless defined as present in part A in accordance with page 9, line 24 to page 10, line 2.

Claims 1, 3-6, 8-15 and 89-100 are rejected under 35 U.S.C. 103(a) as being unpatentable over European Patent No. 96,500 in view of European Patent No. 452,540.

The newly claimed content of difunctional methacrylate monomer of from 10-80 percent by weight in independent claims 1 and 15 is not exemplified in European '500. European '540 teaches the use of from 1-60% of an alkanediol dimethacrylate in first component (A) (page 2, lines 15-16) and exemplifies 20% of ethylene glycol dimethacrylate (page 4, Example 9).

It would have been obvious to employ the alkanediol dimethacrylate such as the exemplified butylene glycol dimethacrylate of European '500 in an amount of as much as 20% shown in European '540 in order to enhance the water and fuel resistance (European '540, abstract, page 2, Use/Advantage section, last line).

Claims 1, 3-6, 8-15 and 89-100 are rejected under 35 U.S.C. 103(a) as being unpatentable over European '540 and Japanese Patent No. 53-144760 in view of European '500.

The newly claimed content of difunctional methacrylate monomer of from 10-80 percent by weight in independent claims 1 and 15 is not recited in Japanese '760. Japanese '760 sets forth each liquid of the two-liquid adhesive as containing polyethylene glycol dimethacrylate.

It would have been obvious to employ the alkanediol dimethacrylate such as the polyethylene glycol dimethacrylate of Japanese '760 in an amount of as much as 20% by weight shown in European '540 in order to enhance the water and fuel resistance (European '540, abstract, page 2, Use/Advantage section, last line).

Claims 2 and 88 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 1, 3-6, 8-15 and 89-100 above, and further in view of Edelman et al.

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The arguments filed March 17, 2003 have been considered but are unpersuasive. The teachings of a reference are not confined merely to the examples. Neither European '500 nor Japanese '760 limit the proportion of the particular alkanediol dimethacrylate in their disclosures. European '540 discloses the use of from 1-60% by weight, and exemplifies as much as 20% by weight of an alkanediol dimethacrylate in a two-part adhesive. The motivation to employ the butylene glycol dimethacrylate of European '500 and the polyethylene glycol dimethacrylate of Japanese '760 resides in European '540 wherein the water and fuel resistance is improved.

The amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

(703) 308-2399 (Fax no. (703) 872-9311)

Monday to Friday, 9:30 to 6:00

rs 3/26/03

ROBERT E. L. SELLERS
PRIMARY EXAMINER